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RealNetworks, INC. Graybeal Jackson Haley LLP 155 - 108th Ave NE Suite 350 Bellevue, WA 98004-5973			EXAMINER HWANG, JOON H	
			ART UNIT 2166	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/818,134

Applicant(s)

BELU, SABIN

Examiner

JOON H. HWANG

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The applicant amended claims 1, 3, 10, 11, 16, 20-22, 24-28, and 30-32 in the amendment filed on 12/19/07.

The claims 1-34 are pending.

Response to Amendment

2. The declaration filed on 12/19/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the Jensen et al. (U.S. Patent No. 6,922,702) reference.

The declaration and exhibit must clearly explain which facts or data the applicant is relying on to show completion of the invention prior to the date of the Jensen reference. The declaration comprises vague and general statements in broad terms about what the exhibit describes along with a general assertion that the exhibit demonstrates a reduction to practice. Thus, the declaration amounts to a mere pleading unsupported by proof or a showing of facts. Applicant may correct this deficiency by giving a clear explanation of the exhibit pointing out exactly what facts are established and relied on by applicant.

See MPEP 715.07(I):

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

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The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Jensen et al. (U.S. Patent No. 6,922,702) reference to either a constructive reduction to practice or an actual reduction to practice. There is no evidence of diligence from a date prior to the date of the Jensen reference continuously up to the date of an actual reduction to practice or up to the date of the current application.

See MPEP 715.07(a):

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

See MPEP 715.07:

Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

See MPEP 2138.06:

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.)

See MPEP 715.07(II):

the actual dates of acts relied on to establish diligence must be provided.

Response to Arguments

3. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 20 and 24 are objected to because of the following informalities:
- "will" in claim 20, line 5, and claim 24, line 15, causes the claim limitations being indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 22-25 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims 22-24 and 29 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are

clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

On page 9, lines 24-28 of the specification applicant has provided evidence that applicant intends computer readable medium in claim 25 to include transmission type media, such as signal, as such the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore the claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1, 10-13, 15-20, and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen et al. (U.S. Patent No. 6,922,702).

With respect to claim 1, Jensen teaches creating, in response to a single action by a user enabled electronic device (i.e., inputting packaging information and preferences via a computer system, wherein a packaging is done without interfacing with a user, line 66 in col. 6 thru line 10 in col. 7, lines 50-62 in col. 14, and lines 7-19 in col. 15), a self-extracting file (lines 27-33 in col. 8). Jensen teaches receiving, from the user enabled electronic device, an input file to be used in creating a self-extracting file

(line 66 in col. 6 thru line 10 in col. 7 and lines 50-62 in col. 14). Jensen teaches creating a self-extracting file using the input file, wherein the input file is automatically launched upon execution of the self-extracting file, without further action by the user enabled electronic device (i.e., the packaging is done without interfacing with the user, lines 61-65 in col. 6, lines 27-33 and 41-51 in col. 8, lines 45-51 in col. 9, lines 25-40 in col. 13, and lines 7-19 in col. 15). Jensen discloses suitable software for each type of file, for example, PowerPoint software program for a PowerPoint file and Word software program for a document file (lines 28-29 and 43-51 in col. 3 and line 39 in col. 15 thru line 10 in col. 16), and as well-known in the art, Word software program is automatically selected for a document type file.

The limitations of claims 10, 20, 26, and 32 are rejected in the analysis of claim 1 above, and these claims are rejected on that basis.

With respect to claim 11, Jensen teaches opening an output file (line 66 in col. 6 thru line 10 in col. 7). Jensen teaches attaching a decompression engine to the output file, wherein the decompression engine is capable of decompressing compressed data to a temporary file (i.e., executable code, lines 11-15 in col. 7 and line 52 in col. 8 thru line 19 in col. 9). Jensen teaches attaching a loader to the output file, wherein the loader configures the output file so as to automatically launch the temporary file after execution of the self-extracting file (i.e., executable code runs an auto-start file, lines 9-19 in col. 8 and lines 45-51 in col. 9). Jensen teaches compressing the received input file according to a pre-selected data compression method (lines 43-54 in col. 7). Jensen teaches attaching an archive header including information about the

compressed input file (lines 16-23 and 43-54 in col. 7). Jensen teaches closing the output file, wherein the closed output file is the self-extracting file (lines 9-19, 27-33 and 41-51 in col. 8).

With respect to claim 12, Jensen teaches receiving the input file from a user enabled electronic device (line 66 in col. 6 thru line 10 in col. 7).

With respect to claim 13, Jensen teaches receiving the input file from a software routine (i.e., a directory is selected as an input file and files in the directory are also processed by a software routine in creating a self-extracting file, line 66 in col. 6 thru line 10 in col. 7 and lines 32-42 in col. 7).

With respect to claim 15, Jensen teaches the data compression method is determined based on the file type of the received input file (line 66 in col. 4 thru line 14 in col. 5 and lines 43-54 in col. 7).

With respect to claim 16, Jensen teaches the loader attached to the output file depends on the file type of the input file (i.e., auto-start file, lines 9-19 in col. 8, lines 34-39 and 45-51 in col. 9, lines 25-40 in col. 13, and line 39 in col. 15 thru line 6 in col. 16).

With respect to claim 17, Jensen teaches the loader automatically unloads the temporary file (i.e., executable code automatically unpacks, line 52 in col. 8 thru line 7 in col. 9).

With respect to claim 18, Jensen teaches attaching an unloader to the output file to automatically unload the temporary file (i.e., executable code, lines 11-15 in col. 7, and line 52 in col. 8 thru line 19 in col. 9).

With respect to claim 19, Jensen teaches the unloader performs clean up processes on the temporary file (lines 55-67 in col. 7, line 52 in col. 8 thru line 7 in col. 9, and lines 20-33 in col. 9).

The limitations of claims 25 and 30 are rejected in the analysis of claims 10 and 11 above, and these claims are rejected on that basis.

With respect to claim 27, the limitations of claim 27 are similar to the limitations of claim 1 above. Jensen further teaches the executable file includes a compressed copy of the input file, and wherein the compressed copy of the input file is automatically decompressed (lines 43-54 in col. 7 and lines 8-19 in col. 9). Therefore, the limitations of claim 27 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

With respect to claims 28, Jensen teaches the packaging and unpackaging processes are done without any user intervention (lines 7-19 in col. 15). This teaches the packaging and unpackaging processes are automatically done. Therefore, the limitations of claim 28 are rejected in the analysis of claims 10 and 11 above, and the claim is rejected on that basis.

The limitations of claim 29 are rejected in the analysis of claim 28 above, and the claim is rejected on that basis.

The limitations of claim 31 are rejected in the analysis of claim 27 above, and the claim is rejected on that basis.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 3-5, 7-8, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (U.S. Patent No. 6,922,702) in view of Basin et al. (U.S. Patent No. 6,879,988).

With respect to claim 3, Jensen teaches creating, in response to a single action by a user (i.e., inputting packaging information and preferences, wherein a packaging is done without interfacing with a user, line 66 in col. 6 thru line 10 in col. 7, lines 50-62 in col. 14, and lines 7-19 in col. 15), a self-extracting file from an associated input file (lines 27-33 in col. 8). Jensen teaches the associated input file is automatically launched upon execution of the self-extracting file, creating a compressed archive using a chosen compression method, selecting an input file to be launched upon decompression of the compressed archive, and creating a self-extracting file from the compressed archive (line 66 in col. 6 thru line 26 in col. 8). Jensen teaches receiving an input file to be used in creating a self-extracting file, wherein the file is one of a plurality of file types (line 66 in col. 6 thru line 10 in col. 7 and lines 50-62 in col. 14). Jensen teaches in response to only a single action, creating a self-extracting file from the input file, wherein the input file is automatically launched upon execution of the self-extracting file (lines 61-65 in col. 6, lines 27-33 and 41-51 in col. 8, lines 45-51 in col. 9, lines 25-40 in col. 13, and lines 7-19 in col. 15). Jensen teaches providing a user with a file compression method option to select (line 66 in col. 4 thru line 14 in col. 5). Jensen does not explicitly disclose a user is not required to separately choose a data compression method. However, Basin

teaches a default file compression method being used in creating a new zip file (lines 45-54 in col. 3). This default file compression would produce a simpler user interaction since the default file compression would eliminate the compression method selection option, thereby resulting less user interaction with the system. Therefore, based on Jensen in view of Basin, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Basin to the system of Jensen in order to provide a simpler user interaction.

With respect to claims 4-5 and 7-8, Jensen teaches receiving the user input via an input device, such as mouse (single or double click), keypad, keyboard (pressing a key), or any combination thereof (lines 31-37 in col. 3, lines 1-9 in col. 4, line 66 in col. 6 thru line 10 in col. 7, lines 41-51 in col. 8, and line 66 in col. 9 thru line 11 in col. 10). Jensen teaches the single action is a call from a software routine (i.e., a directory is selected as an input file and files in the directory are also processed by a software routine in creating a self-extracting file, line 66 in col. 6 thru line 10 in col. 7 and lines 32-42 in col. 7).

The limitations of claim 24 are rejected in the analysis of claim 3 above, and the claim is rejected on that basis.

11. Claims 2, 14, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (U.S. Patent No. 6,922,702) in view of Babic ("The Lharc/LHA Archiver" modified on November 11, 1997 by Mille Babic, retrieved from <http://user.tninet.se/~gcc561r/archivers/lzh.html> on 9/5/01, 1-3 pages).

With respect to claim 2, Jensen discloses the claimed subject matter as discussed above except automatically generating a filename for the self-extracting file based in part on the associated filename of the received input file. However, Babic shows a filename for the self-extracting file is automatically generated based in part on the associated filename of the received input file (i.e., an output file, "archive.lzh" is automatically generated based in part on an input file, "archive", second page) for the convenience of a user. Therefore, based on Jensen in view of Babic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Babic to the system of Jensen for automatically generating a filename for the self-extracting file based in part on the filename of the input file for the convenience of a user.

With respect to claim 14, Jensen discloses the claimed subject matter as discussed above except using the same compression method for all received input files. However, Babic discloses a compression program, which uses the Lempel-ziv and Huffman algorithms method, and applies such compression method to all received input files (pages 1-3). Therefore, based on Jensen in view of Babic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Babic to the system of Jensen for applying the same compression method to all received input files for one of ways to compress input files.

With respect to claim 21, Jensen teaches allowing a user to specify an input file to be converted to a self-extracting file (line 66 in col. 6 thru line 10 in col. 7 and lines 50-62 in col. 14). Jensen teaches receiving the input file specified by the user, wherein

the received input file is automatically configured as a self-extracting file and wherein the input file is automatically launched upon execution of the self-extracting file (lines 61-65 in col. 6, lines 27-33 and 41-51 in col. 8, lines 45-51 in col. 9, lines 25-40 in col. 13, and lines 7-19 in col. 15). Jensen discloses a graphical user interface (fig. 8). Jensen does not explicitly disclose first and second frames. However, Babic teaches a first frame for inputting an input file and a second frame for displaying a link to the output file (self-extracting file) created from the user specified input file (figures on pages 1-3). Therefore, based on Jensen in view of Babic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Babic to the system of Jensen for first and second frames in order to provide a user with a convenient user interface (a graphical user interface) for data operations.

With respect to claim 22, Jensen teaches a receiving module configured to receive an input file, wherein the input file received is one of a plurality of file types and wherein the input file includes an associated filename (line 66 in col. 6 thru line 10 in col. 7, and lines 50-62 in col. 14). Jensen teaches a naming module configured to create and name an output file (line 66 in col. 6 thru line 10 in col. 7). Jensen teaches a self-extracting module configured to transform the output file into an executable file, wherein the self-extracting module receives the input file and the output file from the naming module (line 66 in col. 6 thru line 15 in col. 7). Jensen teaches a loader module configured to setup the executable file to launch the input file upon execution of the executable file, wherein the loader module receives the executable file and the input file from the self-extracting module (i.e., executable code runs an auto-start file, lines 9-19

in col. 8 and lines 45-51 in col. 9). Jensen teaches a compressing module configured to compress the input file and attach the compressed input file to the executable file, wherein the compressing module receives the input file and the executable file from the loader module (lines 43-54 in col. 7). Jensen does not explicitly disclose generating a filename for the self-extracting file based on the associated filename of the received input file. However, Babic shows a filename for the self-extracting file is automatically generated based on the associated filename of the received input file (i.e., an output file, "archive.lzh" is automatically generated based in part on an input file, "archive", second page) for the convenience of a user. Therefore, based on Jensen in view of Babic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Babic to the system of Jensen for automatically generating a filename for the self-extracting file based in part on the filename of the input file for the convenience of a user.

With respect to claim 23, Jensen discloses the loader module is configured to setup the executable file to perform unload processes (i.e., executable code automatically unpacks, line 52 in col. 8 thru line 7 in col. 9).

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (U.S. Patent No. 6,922,702) in view of Basin et al. (U.S. Patent No. 6,879,988), and further in view of Rourke et al. (U.S. Patent No. 6,668,244).

With respect to claim 6, Jensen discloses an input device, such as mouse and keyboard, for inputting an input command (lines 31-37 in col. 3). Jensen and Basin do

not explicitly disclose a sound command. However, Rourke discloses a voice command input via microphone device (fig. 1 and fig. 2) as an alternative way to input an input command. Therefore, based on Jensen in view of Basin, and further in view of Rourke, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Rourke to the system of Jensen for a voice command in order to provide a user another alternative way to input an input command.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (U.S. Patent No. 6,922,702) in view of Basin et al. (U.S. Patent No. 6,879,988), and further in view of Babic ("The Lharc/LHA Archiver" modified on November 11, 1997 by Mille Babic, retrieved from <http://user.tninet.se/~gcc561r/archivers/lzh.html> on 9/5/01, 1-3 pages).

With respect to claim 9, Jensen and Basin disclose the claimed subject matter as discussed above except automatically generating a filename for the self-extracting file based in part on the associated filename of the received input file. However, Babic shows a filename for the self-extracting file is automatically generated based in part on the associated filename of the received input file (i.e., an output file, "archive.lzh" is automatically generated based in part on an input file, "archive", second page) for the convenience of a user. Therefore, based on Jensen in view of Basin, and further in view of Babic, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Babic to the system of Jensen for

automatically generating a filename for the self-extracting file based in part on the filename of the input file for the convenience of a user.

14. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al. (U.S. Patent No. 6,922,702) in view of Luck ("Petite Win32 Executable Compressor" version 2.2 available on 12/15/1999, retrieved from <http://www.un4seen.com/petite/> on 9/5/2001, 1-2 pages).

With respect to claims 33 and 34, Jensen discloses the claimed subject matter as discussed above except the input file is an executable routine or dynamic link library file. However, Luck discloses an input file can be an executable routine (exe files) or dynamic link library (dll files) for compression (pages 1-2). Therefore, based on Jensen in view of Luck, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Luck to the system of Jensen for the executable routine or dynamic link library file as an input file for compression in order to save a size of the input file.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOON H. HWANG whose telephone number is (571)272-4036. The examiner can normally be reached on 9:30-6:00(M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joon Hwang
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Technology Center 2100

3/13/08
/Joon H. Hwang/
Primary Examiner, Art Unit 2166